

Notice of Allowability**Application No.**

10/646,266

Examiner

Hector M Reyes

Applicant(s)

HALLINAN, E. ANN

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 2/10/05.
2. ☒ The allowed claim(s) is/are 2, renumbered as 1.
3. ☒ The drawings filed on 25 August 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 10/15/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Art Unit: 1625

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group II, consisting of claim 1 in part, 2-4 drawn to 2-amino -7-(ethanimidoethylamino)-2-methylhept-5-oic acid and its salts as described in the said claims in the reply filed on 10/18/04 is acknowledged. Examiner also acknowledges Applicant's Amendment, Remarks and OWNERSHIP STATEMENT and Assignments Documents received on February 10, 2005.

Status of The Claims

Claims 1, 3, 4 and 5-7 and 8 have been canceled. Claim 2 has been amended. Claim 2 is currently under Examination. The said claim is hereby renumbered as claims 1.

ALLOWANCE

In claims 1 as renumbered Applicant claims:

- The particular crystalline 1.5 hydrochloride salt of the particular (2S, 5Z)-2-amino-2-methyl-7-[(1-iminoethyl)amino]-5-heptenoic acid.

No prior art disclosing or suggesting the said salt was not found. The closest art relevant to the said compound was founds in:

- Manning et al, WO 02/076395 A2 and
- Hansen et al, WO 02/22562.

Manning et al discloses the preparation of (2S, 5Z)-2-amino-2-methyl-7-[(1-iminoethyl)amino]-5-heptenoic acid dihydrochloride salt (2HCL), see page 177, compound LL.

Art Unit: 1625

Hansen et al also discloses (2S, 5Z)-2-amino-2-methyl-7-[(1-iminoethyl)amino]-5-heptenoic acid dihydrochloride salt, (2HCL) see Example 13, page 101.

The cited references however do not disclose or suggest the preparation of corresponding 1.5 HCL salt.

Notice that Applicant has provided a clear statement addressing the issue of Common Ownership in order to disqualify Hansen's reference as prior art.


Statement of Common Ownership, Duty to Assign Invention

Applicant's representative makes the following statement, to disqualify U.S. Serial Number 09/953,049, (published as US 2002-0132849 A1, September 19, 2002) and filed September 15, 2001, (now allowed), and/or WO 02/22562 A1 (published March 21, 2002, the International (PCT) application corresponding to U.S. 09/953,049) as prior art. The above references should be disqualified as prior art in the instant application, because the instant application was filed after November 29, 1999, and subject to an obligation of assignment at the time of the invention. Note that the instant application, U.S. Serial Number 10/646,266 claims priority to U.S. Provisional Application Serial Number 60/405,526, filed August 23, 2002. Therefore, the instant application was filed less than one year prior to the publication of WO 02.22562 and US 2002-0132849.

Applicant's representative hereby states that the claimed subject matter for the present application, U.S. Serial No. 10/646,266 is commonly owned, and was subject to an obligation of assignment to the same organization, Pharmacia Corporation, at the time the invention was made. As evidence of common ownership, a copy of the assignment document for U.S. Serial Number 09/953,049, recorded at Reel/Frame 012704/0954 and the instant application, U.S. Serial Number 10/646,266, recorded at Reel/Frame 014592/0982, are attached as an appendix to this paper.

If the Examiner believes a telephonic interview with Applicant's representative would aid in the prosecution of this application, he is cordially invited to contact Applicant's representative at the below listed number.

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Corporate Patent Department
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CONCLUSION

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany

Art Unit: 1625

the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

All post-Allowance Correspondence concerning this Application must be mailed to:

**BOX ISSUE FEE
COMMISSIONER FOR PATENTS
WASHINGTON, DC 20231**

Or you can fax them to the Office of Patent Publications at 703-308-5083, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027.

Héctor M. Reyes PhD, JD
US PTO registration P-54846
AU 1625
February 10, 2005.

Rita Desai
Primary Examiner

RDesai
2/14/05